

REMARKS

This Amendment responds to the Office Action mailed March 16, 2004.

Since there was no Office Action Summary Sheet included with the Office Action, Applicants presume that the drawings filed are accepted by the Examiner. If this is incorrect, please include an indication to the contrary in the next Office Action.

In the unnumbered first paragraph of the Office Action, claims 1-10 are rejected under 35 U.S.C. § 101 as being “directed to non-statutory subject matter.” In particular, the Office Action contends that the claims are “not tied to the technological arts.” Applicant respectfully traverses this rejection.

The fact that claims 1-10 meet the useful, concrete, and tangible result requirement for patentable subject matter under 35 U.S.C. § 101 is inherently admitted in the Office Action. As far as Applicant is aware, meeting of this test alone satisfied the requirement under § 101.

As stated in State Street Bank and Trust Co. v. Signature Financial Group, Inc., 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998), a claim satisfies the requirements of 35 U.S.C. § 101 if “the practical application of the abstract idea produces a useful, concrete, and tangible result.” Applicant is unaware of any further test as indicated in the Office Action which requires automated generation of the e-mail content which can be generated by hand.” This test is neither specified in the statute, the Code of Federal Regulation nor in currently applicable law of the United States. Significantly, this test has never been required by the courts. In applying this test, the Office Action states that the claims are not tied to the technological arts” and, apparently that the method could be carried out completely by hand (i.e., entirely by a human). Applicant respectfully submits that this test is quite contrary to long-standing law and it is irrelevant whether the steps of the claims can be carried out by hand.

Steps carried out by humans are okay if they satisfy the useful, concrete, and tangible result test. Specifically, in In re Musgrave, 431 F.2d 882, 893; 167 U.S.P.Q. 280, 289 (CCPA 1970), the Court expressly stated that a method remains statutory even if all the steps therein can be carried out in the human mind.

In fact, Applicant respectfully submits that the present invention is clearly within the definition of patentable subject matter or “technical arts” that is stated in the Office Action. The United States Supreme Court has stated that patentable subject matter has been interpreted to be “anything under the sun that is made by man.” Diamond v. Chakrabarty, 447 U.S. 303 (1980). What may not be patented has been identified by the Supreme Court as “laws of nature, natural phenomenon, and abstract ideas.” Id. at 309. The present invention is not claiming any of these non-patentable subjects. In addition, there has been no requirements by the courts of the United States that method claims cannot be entirely carried out by hand, nor has the Examiner cited any cases stating such a requirement.

As such, the currently pending claims clearly satisfy the requirements of 35 U.S.C. § 101. Accordingly, this rejection must be withdrawn as there is no reasonable basis to apply it in the present case.

In paragraph 1 of the Office Action, claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner has recited the language of each claim and in certain instances has placed specific comments within parenthesis as a basis for each rejection.

With respect to claim 1, the Examiner has not recited any comments within parentheses, therefore this claim is presumed to be unrejected.

Claim 2 recites “generating a web file.” The Examiner asserts that the scope of “generated” is unclear and questions what a web file is. In response, Applicant asserts that

a web file is well known in the art, and the claim is not limited to generating a web file by computer. The preferred embodiment illustrates an example of generating a web file starting at page 12, line 14 and illustrated in Fig. 3. Therefore, Examiner's rejection of this claim should be withdrawn.

Claim 3 recites "generating an image of said exception item." The Examiner comments that "generating an image" is unclear. Applicant respectfully traverses, and notes that generating an image is well known in the art, and that such image generation should not be limited to the preferred embodiment, which is described in some detail starting at page 8, line 7. Therefore Examiner's rejection should be withdrawn.

Claim 4 recites a "scrubbing process." The Examiner asserts that scrubbing process is undefined. Applicant traverses, noting that a scrubbing system is described in detail starting at page 8, line 18 and continuing to page 9, line 10. Therefore Examiner's rejection should be withdrawn.

As with claim 1, claims 5 and 7-9 do not include any comments from the Examiner, and are presumed to be unrejected.

Claim 6 recites the acronym "SMTP." The Examiner comments that such recitation is undefined and improper. Applicant has amended claim 6 to recite "simple mail transfer protocol," which is defined on page 13, lines 9-10. These changes do not affect the scope of this claim.

Claim 10 recites a variety of steps related to the generation, transmission, reception, and processing of e-mail. The Examiner comments that "it is not clear if the steps are being performed by hand or under a control of a computer-run algorithm." Applicants respectfully traverse, noting that e-mails are inherently electronically-transferred communications, whether they are generated by hand or by computer is immaterial, and that the claim's scope encompasses all means of processing e-mails. A non-limiting example of such handling is disclosed in the Detailed Description of the Preferred

Embodiment in the specification of the application. Therefore, the Examiner's rejection should be withdrawn.

In paragraphs 2 and 3 of the Office Action, claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art. The Examiner points to Applicant's response to the § 1.105 requirement. In this response, Applicant states that "[t]he features of the present invention which represent improvements over the prior art systems include the email notification of exception items, the web file containing the exception item and including the address for the web file in the email notification, and the inclusion of images in this web file." The Examiner then states that "it would have been obvious to include e-mail notification of the exception items including an image of the check." The Examiner does not even assert that it would have been obvious to generate or use a Web file, include an image of the exception item in the Web file, or generate or include an address for the Web file in the e-mail notification. Claims 2, 3, 5, 8 and 10, recite these features, which were noted in Applicant's earlier response, but the Examiner has not even alleged that the prior art teaches or suggests all of these features or that Applicant has admitted that these features as being prior art. Furthermore, none of the claims recite "e-mail notification . . . including an image of [a] check," which the Examiner stated in his rejection. Because the Office Action fails to provide a citation to a reference or references which disclose each and every element of the rejected claims, a *prima facie* case of obviousness has not been made. Therefore, on this basis alone, the Examiner's rejection should be withdrawn.

Additionally, in order to establish a *prima facie* case of obviousness the Examiner must provide "some suggestion or motivation, either in the references themselves or in their knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." See MPEP § 2143. For this additional reason, a *prima facie* case of obviousness has not been presented, the Examiner's rejection on these grounds is respectfully traversed.

As to motivation, the Examiner states that it would have been obvious to modify Applicant's admitted prior art to arrive at the claimed invention because the "motivation being increased speed of resolution and reduced costs." The fact that a recited feature is advantageous cannot be held against the Applicant and cannot substitute for the motivation that must be shown by the Examiner. If the Examiner intends to maintain this rejection, he is requested to explain exactly what teachings in the prior art would have motivated someone to make the modification. It was Applicant who discovered the advantageous claim features and the Examiner has offered no evidence whatsoever that such advantages were recognized in the prior art so as to provide for a possible motivation for its modification. As such, no *prima facie* case of obviousness has been set forth.

The fact that Applicant's invention increases the speed of resolution and reduces the cost of processing exception items is not evidence that it would have been obvious to have added features that promote such efficiency. On the contrary, the fact that the prior art has no teaching or suggestion of a feature, combined with the fact that the feature is particularly advantageous, is evidence of *non-obviousness*, not its opposite. If the rule stated in the Office Action were followed, then the most advantageous inventions would be the most obvious. Of course this is not true.

The motivation to use Web files and e-mail notification to resolve exception items has not been shown to be taught or suggested in the prior art. Modification of prior art exception processing methods to include Web files and e-mail notification amounts to improper hindsight to reconstruct the claims. Therefore, such modification is deficient and for at least this reason no *prima facie* case of obviousness has been established. Therefore, in the absence of any disclosure or suggestion of these features of the invention, claims 1-10 are believed to be in condition for allowance.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Reconsideration of the application and allowance of the claims are earnestly solicited.

Dated: July 16, 2004

Respectfully submitted,

By 

Robert G. Ginger

Registration No.: 45,755

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant